

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general concept under PCT Rule 13.1.

The species are as follows:

- The compounds of formula I wherein R^1 and R^2 do not combine to form a ring.
- The compounds of formula I wherein R^1 and R^2 are joined together to form a heterocyclic ring system as defined by claim 1.
- The disease to be treated with the instantly claimed compounds/compositions.

(Office Action mailed February 06, 2009, page 3) Applicants respectfully request the Examiner to clarify whether the instant invention has been restricted into two or three groups.

In response to the restriction requirement, Applicants hereby elect Group I, claims 1-11, directed to compounds and compositions.

In the event that the Examiner has further restricted Group I into two subgroups (a) claims 1-11, wherein R^1 and R^2 do not combine to form a ring and (b) claims 1-11, wherein R^1 and R^2 are joined together to form a heterocyclic ring system as defined by claim 1, Applicants hereby provisionally elect to prosecute Group I(a), claims 1-11, wherein R^1 and R^2 do not combine to form a ring to be fully responsive to the restriction requirement. Notwithstanding the foregoing provisional election, Applicants respectfully traverse the restriction between subgroups (a) and (b).

Applicants respectfully disagree with the Examiner's conclusion for the following reasons. The Examiner appears to be following the Restriction practice re: Markush-type claims outlined in MPEP §803.02. Applicants respectfully point out that the circumstances under which an Examiner can carve up a Markush group claim prior to examination on the merits are quite limited. In particular,

... it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. ... Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature essential to that utility.

MPEP §803.02 (citations omitted).

Applicants respectfully submit that the class of compounds recited in claim 1 (formula I) of the instant application satisfies the two requirements for unity of invention. First, Applicants' claimed compounds all possess common utility, that being an ability to bind to the

glucocorticoid receptor. Applicants' compounds are thereby clinically relevant to a number of biological processes such as selectively modulating the activation, repression and agonism effects of the glucocorticoid receptor in a mammal (see, for example, specification as filed, page 9, lines 26 - 29).

Second, Applicants' compounds all have substantial structural feature that has been clearly disclosed as being essential to the aforementioned utility (see, for example, specification as filed, pages 2-6). In particular, Applicants' compounds possess a core structure of 4 fused rings. Various specified substituents are attached to the open positions on the core structure. Thus, compounds of the instant claim 1 satisfy the two requirements for unity of invention.

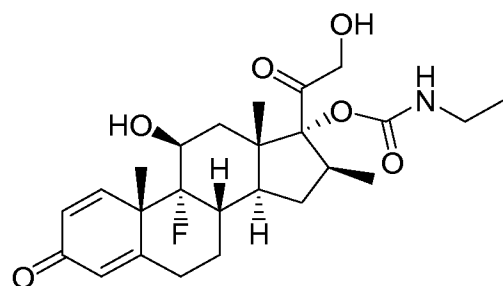
Additionally, MPEP contains an additional necessary condition that must be met by an examiner before the examiner can impose a restriction requirement. This is the requirement to show that there is a "serious burden" on the examiner to search and examine the allegedly independent or distinct claims. Specifically, MPEP 803 states that:

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

MPEP §803 second paragraph.

Applicants note that, although the Examiner has stated, conclusorily, that the compounds of Applicants Markush group "are deemed to lack unity of invention because they are not so linked as to form a single inventive concept", the Examiner has not articulated, chemically, which aspects of the structure would deny members of the group a common utility, and why the structure in question is not susceptible to searching. Thus, in the absence of a specifically articulated reason why Applicants' claimed compounds are not properly examined as a single group, Applicants respectfully request that the restriction between subgroups (a) and (b) be withdrawn.

In response to the requirement to elect a species, applicants hereby elect the compound having the following structure as appearing on page 20 as originally filed:



Claims readable thereon are 1-11.

Respectfully submitted,

By /Yong Zhao, Reg. # 57014/

Yong Zhao

Reg. No. 57,014

Attorney for Applicants

MERCK & CO., INC.

P.O. Box 2000

Rahway, New Jersey 07065-0907

(732) 594-7338

Date: February 18, 2009